

## **REMARKS**

Claims 1-10 and 13-108 are pending.

Claims 1-10 and 13-108 stand rejected.

### **35 U.S.C. § 103**

Claims 1-10 and 13-108 stand rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,446,653 to Miller et al. (“*Miller*”) in view of U.S. Patent No. 5,692,206 to Shirley et al. (“*Shirley*”) and U.S. Patent No. 7,007,227 to Constantino et al. (“*Constantino*”). Applicants respectfully traverse the rejection.

Applicants respectfully submit that, as demonstrated below, *Miller* in view of *Shirley* and *Constantino* fails to teach or suggest, for example, that “at least one of the component-to-component relationships [included in the rules] identifies under what circumstances to include a first document component in the document when a second document component is included in the document.” Claim 1.

### **COMMENTS ON THE EXAMINER’S “RESPONSE TO ARGUMENTS” and “ADVISORY ACTION”**

In the Response to Arguments section of the current Office Action, the Examiner refers to *Miller* and the EPA Pamphlet “Protect Your Family From Lead in Your Home” (referred to herein as the “EPA Document”). Office Action, pp. 2-3. The Examiner states that *Miller* “teaches generation of documents by adding or substituting of content of documents to ensure that the generated documents are valid in the state of the entity for whom the documents are generated [*Miller*, col. 3, lines 42-48].” Initially, Applicants point out that *Miller*, col. 3, lines 42-48 does not refer to adding but only refers to substitution, i.e. a “substitute clause”. *Miller*, col. 3, lines 38-48 state:

Means responsive to the determining means identify **a substitute clause** instead of the tentatively identified clause in the event that the tentatively identified clause is invalid for use in the insurance policy. For example, a tentatively identified clause may not be valid for use in a particular state. In this instance, the entered coverage information (which includes the policy owner's state) is used to

determine that **a substitute clause** must be provided instead of the tentatively identified clause in order for the policy to be valid in the policy holder's state. (emphasis added).

The foregoing section does not refer to adding a clause. *Miller*, col. 3, lines 42-48 refers only to a **substitute** clause and not inclusion of a second clause when a first clause is included.

Contrary to *Miller*, col. 3, lines 42-48, claim 1 specifically refers to ‘inclusion’ and not substitution, i.e. claim 1 recites, “at least one of the component-to-component relationships [included in the rules] identifies under what circumstances to include a first document component in the document when a second document component is included in the document.” **Therefore, the teachings of ‘substitution’ in *Miller*, col. 3, lines 42-48 clearly fail to teach or suggest the foregoing portion of Claim 1.**

The Response to Arguments also refers to *Miller*, col. 3, line 64-col. 4, line 2. Applicants assume that the reference is actually to col. 2, line 64-col. 3, line 2 as identified on p. 4 of the Office Action. In col. 2, line 64-col. 3, line 2, *Miller* refers to selection of a clause, but the selection is not based on inclusion of another clause. *Miller*, col. 2, line 64-col. 3, line 2 recites:

The rule sets can each comprise, for example, at least one character identifying either a rule or a coverage and at least one operator to be applied to the character. In this manner, individual clauses can be associated with a specific coverage or group of coverages, and **the clause** will be selected only if **the coverage(s)** selected require that clause.

Thus, *Miller* teaches a rule set that selects a clause if a certain coverage(s) is selected that requires that clause. **However**, the **coverage** is not a “document component” as used in claim 1. Rather, the coverage is simply the type of insurance policy to be written. Claim 1 requires not only “receiving input data” but also, “in response to receiving the input data, processing rules to determine which of one or more document components of the plurality of document components to include in a document.” Claim 1. “[T]he rules include component-to-component relationships and at least one of the component-to-component relationships identifies under what circumstances to include a first document component in the document when a second document component is included in the document.” *Id.* Claim 1 also recites, “obtaining each of the plurality of document components to be included in the document as determined by the

processing of the rules.” Thus, the component-to-component relationships are relationships between document components to be included by the processing rules. Thus, these document components are not simply a type of document. Accordingly, including a certain clause upon receipt of coverage input data as taught by *Miller*, also does not teach claim 1.

The Response to Arguments also refers to the EPA Document. The EPA Document teaches that “Sales contracts will include a federal form about lead-based paint in the building.” EPA Document, p. 2. However, the present invention is not directed to simply including a form or document in a sales contract. The EPA Document does not teach any “rules [that] include component-to-component relationships and at least one of the component-to-component relationships identifies under what circumstances to include a first document component in the document when a second document component is included in the document”. The EPA Document does not even discuss any particular document components of the sales contract except *arguably* the “federal form”. (“*arguably*” because it is not clear that the federal form is actually part of the sales contract or is simply informative material that accompanies the sales contract.) Even assuming the federal form is part of the sales contract, the federal form is the only component of the sales contract that is mentioned. Therefore, the EPA Document cannot teach “component-to-component relationships [that identify] under what circumstances to include a first document component in the document when a second document component is included in the document” as required by claim 1.

ADVISORY ACTION COMMENTS. Additionally, in the May 3, 2010 Advisory Action, the Examiner points out that *Miller* teaches, “If a rule set indicates that its associated clause is to be provided in a document based on the document parameters, the number of the clause is added to an output array.” *Miller*, col. 14, lines 38-41. However, the claims in the present application are not merely directed to ‘adding a clause if a rule set so indicated.’ Claim 1 recites, “at least one of the component-to-component relationships [included in the rules] identifies under what circumstances to include a first document component in the document when a second document component is included in the document.” The rule set of *Miller* merely adds a clause. Nowhere in the foregoing teaching of *Miller* does *Miller* teach or suggest

that the rule set teaches “to include a first document component in the document **when a second document component is included in the document.**””

Accordingly, Applicants respectfully submit that the Response to Arguments does not identify any teachings or suggestions in *Miller* or the EPA Document that render claim 1 obvious. As discussed below, the remaining independent claims contain similar distinguishing limitations.

In addition to the foregoing comments, Applicants present the following remarks in support of the patentability of the claims in the Present Application:

*Miller* does teach a rule based document generation system in which “[d]ocuments are automatically generated by assembling a plurality of clauses selected from a library of clauses stored in a computer system.” *Miller*, Abstract. However, simply assembling clauses from a library of clauses to generate a document does not teach that “at least one of the component-to-component relationships [included in the rules] identifies under what circumstances **to include a first document component in the document when a second document component is included** in the document.” Claim 1.

The Examiner cites a May 1995 EPA document that requires sales contracts to include a federal form about lead-based paint in the building. EPA Document, p. 2. The EPA Document teaches a manual process. However, the present invention is not simply the automation of a well-known manual process and is, thus, not taught or suggested by the EPA Document. There is nothing in the EPA document, *Miller*, *Shirley*, or *Constantino* that teach in a computer system that “at least one of the component-to-component relationships [included in the rules] identifies under what circumstances **to include a first document component in the document when a second document component is included** in the document.” Claim 1. Simply including a federal form with a sales contract does not teach or suggest processing rules with a computer system that include “component-to-component” relationships that identify “under what circumstances to include a first component in the document when a second component is included in the document.” *Id.*

As previously elaborated by Applicants, even assuming that the EPA document is a document component of a sales contract, there is nothing to teach or suggest “component-to-component” relationships that identify under what circumstances to include another component in the document when the EPA document is included in the sales contract.

Claim 1 of the Present Application relates to a method for generating documents that includes “receiving input data that includes information useful for generating a document from a plurality of document components.” Claim 1. The method of claim 1 also recites that “in response to receiving the input data, processing rules to determine which of one or more document components of the plurality of document components to include in a document.” Claim 1 also recites that “the rules include component-to-component relationships and at least one of the component-to-component relationships identifies under what circumstances to include a first document component in the document when a second document component is included in the document.” *Id.*

Applicants respectfully submit that *Miller* in view of *Shirley* and *Constantino* fails to teach or suggest, for example, that “at least one of the component-to-component relationships [included in the rules] identifies under what circumstances to include a first document component in the document when a second document component is included in the document.” *Id.*

*Miller* teaches that:

[I]nsurance policies are built from a software library of coverage provisions that can be rearranged and used in any number of ways according to the needs and coverage preferences of a proposed insured.” *Miller*, col. 5, lines 39-43.

[E]ach insurance policy clause has a rule set assigned thereto for use in determining which clauses should be included in a given insurance policy.” *Id.*, lines 57-60.

Each endorsement clause has a corresponding endorsement rule set assigned thereto, for use in providing a list of endorsements that can be selected by a user for an insurance policy being built.” *Id.*, lines 62-66.

In order to create an insurance policy, a user selects one or more desired coverages from a list of coverages displayed at terminal 11. For example, in building a specialty marine insurance policy, the user may be offered, via a menu provided on terminal 11, a choice of property coverages such as Builders' Risk, Computerized Business Equipment, Contractor's Equipment, Installation, and Scheduled Property. The user will also input the name of the proposed policy holder, the policy holder's state of domicile, the effective dates of the policy, and other relevant coverage information. *Id.*, col. 6, lines 22-32.

In response, main processor 13 will test each insurance policy clause rule set provided in library 19 to determine which of the rule sets are satisfied by the entered coverage information. Each of the rule sets contains information identifying which insurance policy clause it corresponds to. The insurance policy clauses that correspond to the rule sets satisfied by the entered coverage information are listed by clause numbers. The endorsement rule sets are then tested to determine which are satisfied by the listed insurance policy clauses. A list of the applicable endorsements is then presented to the user, who selects the endorsements which are desired. The desired endorsements are used to replace insurance policy clauses. *Id.*, lines 33-46.

Table 1 of *Miller* “provides a representative sample of insurance policy rule sets.” See, *Id.*, col. 6, line 51 - col. 7, line 30. From Table 1 and the immediately following rule key indicate when to include or exclude a clause in an insurance policy. Referring to Table 1:

For example, clause 0001 has the rule set A+ assigned to it. The designation A+ means that the associated clause will always be printed in every insurance policy. Thus, clauses 0001, 0405, 9999, and 0025 will be present in every insurance policy created using the rule table. *Id.*, col. 7, lines 38-42.

On the other hand, in order for clause 0353 to appear in an insurance policy, the user must have selected scheduled property ("a") without having selected Builders' Risk ("b"), Contractors' Equipment ("c"), Computerized Business Equipment ("d"), or the Installation Floater ("e"). This result is dictated by rule a+bcde! associated with clause 0353. If the user selected at least two types of coverage, one of them being Contractors' Equipment ("c") and one of Computerized Business Equipment ("d") or the Installation Floater ("e") as indicated by rule c+02#de\*, clause 0361 will be provided in the policy. *Id.*, lines 43-55.

The rules of Table 1 determine conditions under which to include a clause in an insurance policy. Applicants respectfully submit that the rules taught by *Miller* do not “identify[y] under what circumstances to include a first document component in the document when a second document component is included in the document” as required by claim 1.

Accordingly, Applicants respectfully submit that *Miller* fails to teach or suggest that “at least one of the component-to-component relationships [included in the rules] identifies under what circumstances **to include a first document component in the document when a second document component is included** in the document.” Claim 1.

The Office Action cites *Shirley* for teaching a contract generation system that “automates the generation of various legal documents related to a negotiated agreement. *Shirley*, Abstract.

The Office Action cites *Constantino* for teaching “Contracts and statements of work (SOW) are created in a document assembler using model agreements, alternate clauses, and supplemental provisions.” *Constantino*, Abstract.

Applicants respectfully submit that *Miller* in view of *Shirley*, *Constantino*, and the EPA document fails to teach or suggest that “at least one of the component-to-component relationships [included in the rules] identifies under what circumstances **to include a first document component in the document when a second document component is included** in the document.” Claim 1.

For at least similar reasons, Applicants respectfully submit that *Miller* in view of *Shirley*, *Constantino*, and the EPA document fails to teach or suggest:

at least one of the component-to-component relationships [included in the rules] identifies under what circumstances **to include a first document component in the document when a second document component is included** in the document. Claims 15, 35, and 52.

the rules include component-to-component relationships and at least one of the component-to-component relationships identifies under what circumstances to include a first component in the document template when a second component is included in the document template. Claims 29 and 66.

Accordingly, for at least the foregoing reasons, Applicants respectfully request the withdrawal of the rejection of independent claims 1, 15, 29, 35, 52, and 66 and claims directly or indirectly dependent thereon.

## CONCLUSION

The application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned at 512-338-9100.

### CERTIFICATE OF TRANSMISSION

I hereby certify that on May 24, 2010, this correspondence is being transmitted via the U.S. Patent & Trademark Office's electronic filing system.

*/Kent B. Chambers/*

Respectfully submitted,

*/Kent B. Chambers/*

Kent B. Chambers  
Attorney for Applicant(s)  
Reg. No. 38,839